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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,232	04/20/2007	Wataru Nishiumi	71,051-038	9848

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HOWARD & HOWARD ATTORNEYS PLLC
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Royal Oak, MI 48067

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1765

MAIL DATE	DELIVERY MODE
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10/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/584,232	NISHIUMI ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/9/10 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 19-21, 23-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 19-21, 23-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed August 9, 2010 is acknowledged. Claims 15-18 and 22 are deleted. Claims 1, 7-8, 10 and 19 are amended. Claims 23-24 are added. Now, Claims 1-14, 19-21 and 23-24 are pending.
2. Applicants should notice that the claim identifier of Claim 10 should read "(Currently Amended)".
3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 20100302) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102 and 103

5. Rejection of Claims 1-4, 6-10, 12-13 under 35 USC 102(b) as being anticipated by Nagaoka (US 5 378 406), rejection of Claims 5 and 11 under

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35 USC 103(a) as being unpatentable over Nagaoka in view of Insley (US 3 995 184) and rejection of Claims 14 and 19-21 under 35 USC 103(a) as being unpatentable over Nagaoka in view of Insley are maintained because the rejection is adequately set forth in paragraph 11 and 13-14 of Paper No. 20100302. Claims 8 (as amended) and 23-24 are further rejected as set forth below. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Claims 8 and 23-24, Nagaoka teaches the use of titanium compounds such as tetrabutyltitanate, 1,3-dioxypropanetitanate-bis(ethylacetoacetate), etc. (col. 7, lines 12-21)

For Applicants' argument (Remarks, page 11, 2nd paragraph), Examiner disagrees. First, the presently claimed "ferrous ion" can refer to any ***ironic ion*** as taught in Merriam-Webster (Merriam-Webster's Collegiate Dictionary, 10th Ed., Merriam-Webster, Inc. page 430 (1993)) where "ferrous" can broadly be defined as "of, relating to, or containing ***iron***". Second, even though Applicants' narrow interpretation of the claimed term "ferrous ion" was true (which Examiner disagrees), the Nagaoka's iron oxide would be most likely iron(II) oxide because of

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electrically conductive nature of the filler (col. 7, lines 41-46). The support was set forth in paragraph 13 of the previous Office action (Paper No. 20100302). Third, Applicants appeared to further assert that evidence of unexpected results may render the claims both not anticipated and nonobvious. However, as discussed in the first point above, in view of the broad interpretation of the term “ferrous ion”, the presently claimed invention is anticipated by the prior art. As such, Examiner notes that unexpected results cannot overcome anticipation rejections. *In re Malagari*, 182 USPQ 549 (C.C.P.A. 1974) Evidence of secondary considerations, such as unexpected results or commercial success, is **irrelevant** to 35 USC 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). Even for the second point above, Examiner is not able to find the alleged unexpected results (in terms of actual experimental data) derived from the effect of the iron(II) ion, *infra*.

For Applicants’ argument (Remarks, page 12), Examiner notes that there is no issue of “vary[ing] all parameters or try[ing] each of numerous possible choices”, since there are merely three choices to select, i.e., FeO, Fe₂O₃ and Fe₃O₄. If considering the fact that Fe₃O₄ is a one-to-one mixture

of FeO and Fe₂O₃, then the possibility of choosing FeO is even higher. However, most importantly, there are **finite number** (i.e., at most one out of three) of identified solutions with **predictable solutions** (i.e., FeO would yield the predictable result of **enhancing the electrical conductivity** that is a particularly desired property of Nagaoka's filler).

For Applicants' argument (Remarks, page 13, 1st paragraph), Examiner disagrees, noting that with the broad interpretation of the term "ferrous ion", *supra*, all the claimed limitations are met. Even the term is narrowly interpreted (which Examiner disagrees, *supra*), it would have been obvious to choose FeO as a filler in Nagaoka's composition for the reason set forth above.

For Applicants' argument (Remarks, page 13, last paragraph bridging to page 14, 1st paragraph), Examiner disagrees. First, Applicants' Examples and Comparative Example merely show the effect of the **presence vs. absence** of (2-pyridylthio-1-oxide) zinc salt **AND** the polydimethylsiloxane end-capped with trimethylsiloxy groups. Second, the use of (2-pyridylthio-1-oxide) **zinc** salt in the aforementioned Examples is not commensurate with the scope of the claimed invention where a **bis**(2-pyridylthio-1-oxide) **non-ferrous metal** salt is employed. Third, Examiner

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notes that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971) Here, Nagaoka's example is merely a preferred embodiment. As such, Nagaoka certainly does not teach away the broader disclosure as follows: Nagaoka's Component D) is a bis(3-pyridylthio-1-oxide) zinc salt, and the amount of which can be **0.001 to 25** parts by weight, preferably from **0.01 to 1** part by weight. (col. 6, lines 58-65) Thus, one of ordinary skill in the art would **immediately envisage** the claimed amount of the bis(2-pyridylthio-1-oxide) non-ferrous metal salt with **sufficient specificity** at least for the ranges overlapped with that of the presently claimed invention, since Nagaoka's examples further demonstrate the employment of component D) in an amount of **0.1** part by weight, which is located at the far lower portion of the foregoing ranges.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained

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from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
October 8, 2010

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796